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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

David B. Smith
MICHAEL BEST & FRIEDRICH
100 East Wisconsin Ave.
Milwaukee, WI 53202

(For Patent Owner)

James A. Flight
MARSHALL O'TOOLE GERSTEIN
MURRAY & BORUN
6300 Sears Tower
Chicago, IL 60606-6402

(For Requester)

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REEXAM UNIT

In re reissue application of
Megens
Application No. 08/747,873 ✓
Filed: November 13, 1996
For: U.S. Patent No. 5,042,103

In re reissue application of
Megens
Application No. 09/598,785
Filed: June 20, 2000
For: U.S. Patent No. 5,042,103

In re Megens
Reexamination Proceeding
Control No. 90/006,053
Filed: July 9, 2001
For: U.S. Patent No. 5,042,103

DECISION ON
MERGER OF
REEXAMINATION
AND REISSUE
PROCEEDINGS

The above-identified reissue applications and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should remain merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,042,103 issued to Megens, on August 27, 1991.
2. A first reissue application was filed on the '103 patent on September 22, 1995, and was assigned application no. 08/532,415. The '415 reissue application is now abandoned.
3. A second reissue application, which is a continuation of reissue application no. 08/532,415, now abandoned, was filed on the '103 patent on November 13, 1996, and was assigned application no. 08/747,873. A non-final rejection was mailed on March 27, 2001, in the '873 continuation reissue application, and a response to the non-final rejection, including drawings, was received on August 27, 2001.
4. A third reissue application was filed on the '103 patent on June 20, 2000, and was assigned application no. 09/598,785. A non-final rejection was mailed on May 4, 2001, in the '785 reissue application.
5. A request for reexamination of the '103 patent was filed by a third party requester on July 9, 2001, and the resulting reexamination proceeding was assigned Control No. 90/006,053. On September 13, 2001, reexamination was ordered in the '6053 proceeding.
6. A response to the non-final rejection was received in the '785 reissue application on October 4, 2001.
7. No patent owner's statement under 37 C.F.R. § 1.530 was received in the '6053 proceeding.
8. A decision merging all three proceedings was mailed on April 29, 2002, which indicated that each reissue proceeding will proceed **independently, but simultaneously**, within the merged proceedings, and the reexamination file will remain dormant.
9. On June 3, 2002, the patent owner sent in corrected amendments for both the '785 and '873 reissue proceedings, as required in response to the merge decision. (Note that the reexamination file has remained dormant, per the April 29, 2002, decision.)

10. On March 26, 2003, a supplemental amendment including a statement of support was filed in both the '873 and '785 reissue proceedings.
11. A final rejection was mailed in both of the '785 and '873 reissue proceedings on March 28, 2003.
12. On July 31, 2003, a letter of express abandonment was filed in the '785 reissue proceeding, and a request for an extension of time of one month was requested in the '873 reissue proceeding, which was accompanied by a proposed amendment/response to the outstanding final rejection. On same date, the request for an extension of time of one month was granted.

DECISION DISSOLVING MERGER AS TO
REISSUE APPLICATION NO. 09/598,785

The Decision Merging the above-identified Reissue Applications and the Reexamination Proceeding mailed on April 29, 2002, specified that if the applicant/patent owner filed an express abandonment in one of the reissue applications pursuant to 37 C.F.R. § 1.138, then the next Office action of the examiner would accept the express abandonment, and the merged proceeding would be dissolved as to that reissue application. The decision also indicated that the other two cases would remain intact, and must be returned to the Office of Patent Legal Administration for reconsideration of the decision merging proceedings.

Since a letter of express abandonment was filed in the '785 reissue proceeding on July 31, 2003, and has been recognized per MPEP 711.01, the '785 reissue application is abandoned, and therefore the merged proceeding is dissolved as to the '785 reissue proceeding. The merger of the '873 reissue application and the '6053 reexamination proceeding remains intact, and is properly before the Office of Patent Legal Administration for reconsideration of the conduct of the merged proceeding set forth in the previous decision of April 29, 2002.

DISCUSSION OF REMAINING MERGER

The '873 reissue application and the '6053 reexamination proceeding **remain merged**, and reconsideration of the conduct of these merged proceedings is now appropriately before the Office of Patent Legal Administration.

A review of the prosecution history of the '6053 reexamination file shows that the original specification, drawings and patent claims 1-11, are presently in the reexamination file. The reexamination proceeding also contains the decision merging proceedings of April 29, 2002, but no further papers have been added to this file, per the directions set forth in same decision.

A review of the '873 reissue prosecution history shows that the rejections on appeal in this continuation reissue application were affirmed-in-part at the Board of Patent Appeals and Interferences (BPAI), and a non-final Office action was mailed on March 27, 2001. A response to the non-final Office action was received on August 27, 2001, and the decision merging proceedings was mailed on April 29, 2002. Subsequent to the merge decision, a housekeeping amendment was filed on June 3, 2002, which provided the previously filed informal amendments in the appropriate format for reissue applications; and on March 26, 2003, a supplemental amendment including a statement of support was filed in the '873 reissue application. A final rejection was mailed on March 28, 2003, in which claims 1-4, 6-7, 9-12 and 25-28 were rejected; claim 5 was objected to; and claims 13-15 were indicated to be allowable. A response to the final rejection was filed on July 31, 2003, in which the applicant proposes to amend the drawings; to amend the specification, Cols. 1-4; cancel claims 1-7, 9-12 and 25-28; and indicates that claims 13-15 are pending.

Thus, the claims are not identical in both proceedings. In order to provide efficient, consistent and prompt handling of both proceedings, it is appropriate that the reissue application and the reexamination proceeding remain merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION ON THE CONDUCT OF THE REMAINING
MERGED REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The 08/747,873 reissue application and the 90/006,053 reexamination proceeding remain merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

As noted above with regard to the amendments submitted, the drawings, specification, and claims are NOT the same in both files.

However, since all of the amendments subsequent to the merge decision apply to the merged proceeding, and include the appropriate identifiers for the merged cases as directed in the prior merge decision, it is appropriate and now timely for the reexamination file to be physically updated. The merged proceedings will be updated to include all of the same amendments in both of the remaining merged files, specifically, Application No. 08/747,873, and Control Number 90/006,053.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e., the '873 reissue application and the '6053 reexamination proceeding. Each action will be entered into both files (which will be maintained as separate files), and copies will be mailed to the patent owner and the requester.

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (i.e., the reissue Application No. and the reexamination proceeding Control No.). Any such responses must be served on the third party requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(f).

Because the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, any amendments for the merged proceeding should be provided in the proper format for reissue applications.

Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173, therefore all amendments to the specification, claims and drawings should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173. All new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2).

Since the conduct of these merged proceedings will now be the same as the standard type of reissue/reexam merger described in MPEP 2285, subsequent to the mailing of this decision, all papers will be processed in the Office by the Technology Center 3600 personnel.

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance

with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

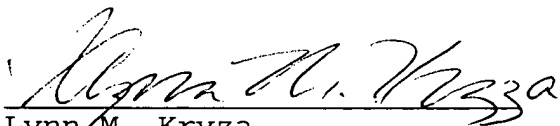
If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The 09/598,785 reissue application is abandoned, and the merger of the above-identified reissue applications and reexamination proceeding into a single consolidated proceeding of April 29, 2002, is **DISSOLVED** as to the 09/598,785 reissue application.
2. The merger of April 29, 2002, continues as to reissue application no. 08/747,873 and reexamination proceeding control no. 90/006,053, which **REMAIN MERGED** as a single consolidated proceeding.

3. The '6053 reexamination file will be updated by the Central Reexamination Unit (CRU) to include all of the same documents entered in reissue application no. 08/747,873, since the previous merge decision of April 29, 2002.
4. A copy of the instant decision will be placed in all three files of the above-identified proceedings.
5. The 08/747,873 reissue application file and the 90/006,053 reexamination file will then be forwarded to Technology Center 2800 for the examiner's immediate consideration of the proposed amendment-after-final of July 31, 2003, in the merged proceeding. All further examination should be conducted in accordance with this decision.
6. The examiner should promptly issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding.
7. All further examination should be conducted in accordance with Parts II and III of this decision.
8. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7722.



Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

March 29, 2005